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PATENT
Atty. Dkt. No. RQC920010002US1
PS Ref. No.: IBMK10002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**In re Application of:
Kepros et al.**

Serial No.: 09/835,731

Filed: April 16, 2001

**For: METHOD AND COMPUTER
SYSTEM FOR PROCESSING
ELECTRONIC REBATES**

Confirmation No.: 5661

Group Art Unit: 3622

Examiner: Jean D. Janvier

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING OR TRANSMISSION

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October 27, 2006
Date

Sanjay Shenoy

REPLY BRIEF

Applicants submit this *Reply Brief* to the Board of Patent Appeals and Interferences in response to the *Examiner's Answer dated August 30, 2006* (hereinafter *Examiner's Answer*). While Applicants' maintain each of the arguments submitted in Applicants' previously submitted *Appeal Brief*, Applicants make the following further arguments in light of the *Examiner's Answer*. Please charge any additional fees that may be required to make this Reply Brief timely and acceptable to Deposit Account No. 09-0465/ROC920010002US1.

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ARGUMENT

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I. THE EXAMINER ERRED IN REJECTING CLAIMS 1, 4-9, 11-13, 15, 16-17, 19-21, 24, 27-32, 34-36, 38 and 39-44 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER QUINLAN, US PATENT 6,748,365b1 IN VIEW OF VAN DUSEN, US PATENT 6,175,823B1.

The Current Rejection

Claims 1, 4-9, 11-13, 15, 16-17, 19-21, 24, 27-32, 34-36, 38 And 39-44 under 35 U.S.C. § 103(A) as being unpatentable over *Quinlan*, (US Patent 6,748,365B1), in view of *Van Dusen*, (US Patent 6,175,823B1).

The Examiner's Definitions

On Page 3, Part 9 of the *Examiner's Answer*, the Examiner provides Examiner's grounds for rejecting the claims. Applicants submit that, for purposes of prosecution, the claims should be given their broadest reasonable interpretation. Further, Irrespective of the claim definitions applied by Examiner, Applicants submit that the claims are patentable as discussed in Applicants' *Appeal Brief* and for the reasons discussed herein.

The Examiner's Arguments

On pages 16-17 of the *Examiner's Answer*, the Examiner provides additional reasons for characterizing *Van Dusen* as analogous art. Specifically, the Examiner indicates that *Van Dusen* is analogous art because *Van Dusen* "deal[s] with commerce or electronic commerce (e-commerce), which is, broadly interpreted, a common field of endeavor." Examiner also cites that *Van Dusen* and the invention are commonly classified in class 705, subclass 14. Examiner further states that *Van Dusen* discloses "a process for solving a common problem, i.e., verifying the authenticity of a rebate claim or a gift certificate claim."

On pages 19 of the *Examiner's Answer*, the Examiner provides additional reasons regarding the motivation to combine *Quinlan* and *Van Dusen* for an

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obviousness rejection under §103(a). Specifically, Examiner suggests that the motivation to combine *Quinlan* and *Van Dusen* exists because *Quinlan* teaches authentication of an electronic rebate and *Van Dusen* teaches authentication of a gift certificate.

On page 17 of the *Examiner's Answer*, the Examiner provides additional clarification with respect to the Examiner's previously submitted arguments regarding claim elements required for the obviousness rejection. Specifically, the Examiner suggests that transmitting, by a rebate server computer system via a network, a purchase identifier to a store computer system that requested the purchase identifier is the same as transmitting a purchase identifier to a remote computer of a recipient of a gift certificate.

Applicants Response to the Examiner's Arguments

With respect to the Examiner's clarifications regarding the status of *Van Dusen* as analogous art, Applicants respectfully maintain that the Examiner has failed to establish that electronic rebates and gift certificates are analogous. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." See MPEP § 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443.

Examiner asserts that *Van Dusen* is analogous because it generally involves commerce or e-commerce, a common field of endeavor. However, e-commerce is an overarching field encompassing a wide variety of commercial transactions over the internet and other computer networks. For example, e-commerce may include electronic funds transfers, supply chain management, online marketing, online transaction processing, inventory management, and the like. Therefore, Applicants respectfully submit that the field of endeavor (e-commerce) defined by the Examiner is overly broad in scope and not reasonably pertinent to the field of endeavor of the Applicants, i.e., rebate processing.

Examiner further asserts that the common classification of the invention and *Van Dusen* in class 705 / subclass 14 establishes that *Van Dusen* is analogous. However, common classification does not conclusively establish that a reference is analogous. See MPEP § 2141.01(a)(II). Rather, "the similarities and differences in structure and function of the inventions carry far greater weight" in establishing whether a reference is analogous. See *Id.*

As discussed in Applicants' *Appeal Brief*, a rebate is fundamentally different from a gift certificate. A rebate is an economic incentive tied to a particular product that is purchased. On the other hand, a gift certificate is itself a product that is separately purchased and subsequently applied to the purchase of other distinct products. Furthermore, rebates benefit a purchaser of a particular product, and are geared to entice purchase of the product. On the other hand, gift certificates are bought by one person for the benefit of another, which is not the case with rebates. Applicants respectfully submit that rebates and gift certificates have fundamentally different functions, and therefore, are not analogous.

Examiner also suggests that *Van Dusen* is analogous because the invention and *Van Dusen* solve a common problem. Specifically, Examiner suggests that both, *Van Dusen* and the invention involve verifying the authenticity of a rebate claim or a gift certificate claim. However, when determining whether a reference is analogous, the Examiner cannot look at isolated teachings of the prior art without considering the overall context within which those teachings are presented. *In re Pagliaro*, 657 F.2d 1219, 1225 (Cust & Pat.App., 1981).

As described earlier, rebates and gift certificates are fundamentally different. Consequently, the problems faced in rebate processing are distinct from the problems faced in gift certificate processing. For example, prior art rebate processing involved cumbersome manual steps such as cutting out product codes from a product, gathering original sales receipts, filling out rebate forms, and mailing these items to the manufacturer. See ¶ 5 of Disclosure. Furthermore, the turn around time for receiving the benefit of the rebate is very long, e.g., often eight to twelve weeks. See ¶ 7 of Disclosure. Gift certificate processing is not faced with any of the problems listed

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above. Therefore, the overall context of gift processing as presented in *Van Dusen* is not relevant to the invention.

Accordingly, *Van Dusen* is not reasonably pertinent to the particular problems with which Applicants were concerned, nor would *Van Dusen* have logically commended itself to the attention of the Applicants in considering these problems. Therefore, Applicants submit that *Van Dusen* is not analogous art.

Applicants further submit that for the same reasons stated above, there is no motivation to combine *Quinlan* and *Van Dusen*. Specifically, *Quinlan* is related to rebate processing while *Van Dusen* is related to gift certificate processing. As established above, gift certificates are fundamentally different from rebates and consequently, the underlying problems associated with rebates and gift certificates are also distinct. Therefore, a person skilled in the art will not be led to look at references related to gift certificate processing for possible solutions related to rebate processing. Therefore, Applicants submit that there is no motivation to combine *Quinlan* and *Van Dusen*.

With respect to Examiner's arguments that *Van Dusen* teaches transmitting, by a rebate server computer system via a network, a purchase identifier to the store computer, Applicants maintain their arguments made in Applicants' *Appeal Brief*. Specifically, Applicants assert that transmitting a gift certificate email containing an identifier by a server to a recipient of the gift certificate is not the same as transmitting a purchase identifier by a rebate server to a store computer that requested the purchase identifier. Therefore, even if *Quinlan* and *Van Dusen* are combined, they do not disclose all the claim limitations.

Withdrawal of the rejection is therefore respectfully requested.

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Conclusion

In conclusion, the cited reference does not teach, show or suggest all of the limitations of the present claims. Accordingly, Applicants respectfully request withdrawal of the rejection of the claims.

Respectfully submitted,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan

Registration No. 44,227

Patterson & Sheridan, L.L.P.

3040 Post Oak Blvd. Suite 1500

Houston, TX 77056

Telephone: (713) 623-4844

Facsimile: (713) 623-4846

Attorney for Appellant(s)